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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91213266
Party	Plaintiff ActII Jewelry, LLC d/b/a lia sophia
Correspondence Address	Milton Springut Springut Law PC 75 Rockefeller Plaza19th Floor New York, NY 10019 UNITED STATES ms@springutlaw.com, tbenschar@springutlaw.com
Submission	Motion to Compel Discovery
Filer's Name	Tal S. Benschar
Filer's e-mail	tbenschar@springutlaw.com, ms@springutlaw.com
Signature	/Tal S. Benschar/
Date	03/24/2014
Attachments	Motion to Compel Discovery Responses.pdf(120340 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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ACT II JEWELRY, LLC d/b/a lia sophia,

*Opposer,*

Opposition No. 91213266

v.

Serial No.: 85/912651

ALISIA & COMPANY

Mark: MIALISIA & CO.

*Applicant.*

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**OPPOSER'S MOTION TO COMPEL RESPONSES  
TO INTERROGATORIES AND DOCUMENT REQUESTS**

In accordance with 37 C.F.R. § 2.120(e) and TBMP § 523, Opposer Act II Jewelry LLC d/b/a lia sophia (hereinafter "lia sophia" or "Opposer") moves to compel responses to outstanding document requests and interrogatories, and in support of which motion relies on the following declaration of its counsel:

TAL S. BENSCHAR declares that:

1. I am a partner of Springut Law P.C., counsel for Opposer in the above-captioned proceeding.
2. On January 23, 2014, we served Opposer's first sets of interrogatories and document requests upon applicant's counsel. Copies of those requests, with certificates of services appended, are attached hereto as Motion to Compel Exhibits A and B. As shown in the certificates of services, the requests were served by both email and U.S. Mail, to the address of Applicant's counsel. (On the same date, we also served Opposer's initial disclosures by the same methods).

3. To date, we have received no responses to these discovery requests. (Applicant served Initial Disclosures on us dated February 10, 2014.)

4. By email correspondence, sent on March 7, 2014, we attempted to confer with Applicant's counsel about this deficiency. A copy of such email correspondence is attached as Motion to Compel Exhibit C.

5. To date, we have received no response from Applicant's counsel.

6. I declare under penalty of perjury that the foregoing is true and correct pursuant to 28 U.S.C. § 1746.

WHEREFORE it is respectfully requested that an order compelling responses to these discovery requests issue from the Board.

Respectfully Submitted,



By: \_\_\_\_\_  
SPRINGUT LAW PC  
75 Rockefeller Plaza, 19th Floor  
New York, New York 10019  
Tel: (212) 813-1600  
*Attorneys for Opposer*  
*Act II Jewelry LLC d/b/a lia sophia*

Date: March 24, 2014  
New York, New York

### **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true copy of the above **OPPOSER'S MOTION TO COMPEL RESPONSES TO INTERROGATORIES AND DOCUMENT REQUESTS** as served upon Applicant's attorney of record, by first class mail, postage prepaid, and by email, addressed to Christopher J. Day, Esq., Law Office of Christopher Day, 9977 North 90<sup>th</sup> Street, Suite 155, Scottsdale, AZ 85258, *chris@daylawfirm.com* on this 24<sup>th</sup> day of March 2014.

By: /S/ Tal S. Benschar  
Tal S. Benschar

**MOTION TO COMPEL**

**EXHIBIT A**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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ACT II JEWELRY, LLC d/b/a lia sophia,

*Opposer,*

Opposition No.

v.

Serial No.: 85/912651

ALISIA & COMPANY

Mark: MIALISIA & CO.

*Applicant.*

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**OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT  
PURSUANT TO 37 C.F.R. §2.120 AND FED.R.CIV.P. 33**

Opposer Act II Jewelry, LLC d/b/a lia sophia (hereinafter referred to as "Opposer"), hereby requests that applicant, Alisia & Company, Inc. (hereinafter referred to as "Applicant"), answer fully and separately in writing and under oath within thirty (30) days after service hereof in accordance with Rule 2.120 of the Trademark Rules of Practice and Rule 33 of the Federal Rules of Civil Procedure the following interrogatories, and produce all documents identified in Applicant's answers to said Interrogatories pursuant to Rule 34 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice.

## **Instructions and Definitions**

A. These interrogatories seek answers as of the date of the execution of same, but shall be deemed to be continuing so that any additional information relating in any way to these Interrogatories which Applicant acquires, or which becomes known to Applicant, up to and including the testimony period shall be furnished to Opposer reasonably and promptly after such information is acquired or becomes known.

B. The following interrogatories shall be construed as addressed to the Applicant, any of Applicant's subsidiaries, affiliated corporations, and any other corporations or business enterprises controlled by Applicant that are presently or were at the time to which the interrogatory relates, associated in any way with the Applicant.

C. If the answer to any interrogatory or subpart thereof is "none," or if a section is not applicable, so indicate rather than leaving the space blank. When a complete answer to a particular interrogatory, or subdivision thereof, is not possible, the interrogatory should be answered to the extent possible, together with the reason stated why only a partial answer is given.

D. If production of any document is withheld on the basis of a claim of privilege, each withheld document must be separately identified by providing the following information, see *Upjohn v. United States*, 449 U.S. 383 (1981):

1. The identity and position of the person or persons supplying the information;
2. The place, date and manner of recording, or otherwise providing the instrument;
3. The names of the person or persons other than stenographic or clerical assistance participating in the preparation of the documents;

4. The name and position of each person to whom the content of the document is addressed or communicated to by copying, exhibiting, reading, or substantial summarization;
5. A general description of the subject matter of the document;
6. The type of privilege claimed (attorney/client or work product);
7. The basis for the claim of privilege;
8. All facts showing that the claimed privilege has not been waived;
9. The status of the entity claiming the privilege; and
10. The portions of the document as to which the privilege is claimed (*i.e.*, one sentence, one paragraph, the entire document, *etc.*).

E. If the information requested is not available from Applicant's records in exactly the form requested, furnish carefully prepared estimates, designated as such, and attach explanations of any estimate used.

F. As used herein, the conjunctions "and" and "or" shall be interpreted conjunctively, and shall not be interpreted disjunctively to exclude any information otherwise within the scope of any interrogatory.

G. As used herein, the term "Applicant" means the Applicant, Applicant's predecessors, divisions, subsidiaries, licensees, franchisees or affiliates, and includes Applicant's present and former officers, directors, partners, agents, employees and all other persons acting or purporting to act on behalf of the Applicant. Where any of the following interrogatories pertain to more than a single entity including Applicant and/or any of Applicant's related companies, answer separately for each such entity, identifying the entity to which such answer pertains.

H. As used herein, the term “subsidiary” means any business enterprise, the operations of which are subject to Applicant’s control through whole or partial ownership of the capital stock.

I. As used herein, the term “person” or “persons” includes not only natural persons, but also, without limitation, firms, partnerships, associations, corporations, joint ventures, and other legal entities, and divisions, departments and units thereof.

J. As used herein, “affiliate” means a company effectively controlled by another, but associated with Applicant under common ownership or control.

K. As used herein, the word “document” or “documents” shall include, without limitation, the following (together with any copies thereof to the extent they differ in any respect from the original, or from another copy): letters, memorandum, disks, tapes and/or video recordings, orders, invoices, contracts, agreements, licenses, assignments, diagrams, hand written notes, periodicals, other publications, pamphlets, reports, records, minute books, books of accounts, studies, instruction sheets, working papers, charts, papers, graphs, blueprints, indices, data sheets, data processing cards, tapes, labels, containers, including originals or copies of the above whether printed, recorded, filmed, written by hand or reproduced by any other process, and any other data compilations from which information can be obtained.

L. As used herein, the term “Electronic data” is defined as all information generated, recorded, preserved, or maintained by electronic means, including, but not limited to information generated, recorded, preserved or maintained on computer hard-drives, floppy computer archives, computer memory, or any other forms of computer readable storage media.



M. As used herein, the word “things” as hereinafter used shall refer to any tangible object that may for some reason be construed as something other than a document.

N. As used herein, “identify” or “state the identity of” means:

1. In the case of a person, to state:

- a. Full name;
- b. The present or last known residence;
- c. The present or last known employer or business affiliation;
- d. The present or last known occupation and business position held.

2. In the case of a company, to state:

- a. Full name;
- b. If incorporated, the place of incorporation;
- c. The address of the principal place of business;
- d. The identity of the person or persons having knowledge of the matter with respect to which the company is named.

3. In the case of a document, to state:

- a. The type of document (*e.g.*, letter, report, *etc.*), general nature or description of the document, and the number of pages or recordings of which it consists;
- b. The date on the document, or if no date appears, to the best of Applicant’s information, recollection and belief, the approximate date on which the document was prepared and recorded;
- c. The name of the person who signed or recorded the document, or if not signed, the author or preparer of the document;

- d. The sender, if different from author;
- e. Addressee(s);
- f. Persons in addition to addressee(s) known to examine same, contemporaneously or subsequently;
- g. Title, caption, label, code, reference, file number, or subject identifying the document;
- h. Substance of the content of the document;
- i. Identity of person having possession, custody or control of the documents; and the present locations of the documents;
- j. Identity of person or persons who can identify the document.

In lieu of such identification, Applicant may simply provide a copy of the document with its answers to these interrogatories and indicate on the document copy which interrogatory the document is being reproduced in response to.

- 4. In the case of an act;
  - a. A description of the act;
  - b. When it occurred;
  - c. Where it occurred;
  - d. The identity of the person or persons performing said act (or, in the case of an omission, the identity of the person or persons failing to act);
  - e. The identity of all persons who have knowledge, information, or belief about the act;
  - f. When the act or omission first became known to Applicant;

g. The circumstances and manner in which Applicant first obtained such knowledge.

O. As used herein, the term “Opposer’s Marks” shall mean the marks LIA SOPHIA and LIA SOPHIA SHARE THE LOVE OF JEWELRY as registered in the United States Patent and Trademark Office and assigned Registration Nos. 2,952,808 and 3,193,032.

P. As used herein, the term “Opposer’s Goods” shall mean jewelry.

Q. As used herein, the term “Applicant’s Mark” shall mean the mark “MIALISIA & CO.” as filed with the United States Patent and Trademark Office and assigned Trademark Application Serial No. 85/912651.

R. As used herein, the term “Applicant’s Goods” shall mean the goods provided by Applicant in relation to Applicant’s Mark as filed with the United States Patent and Trademark Application Serial No. 85/912651.

S. As used herein, the term “Commercial Dealings” shall include the acquisition, shipment, sale, offer for sale, advertisement or transfer of title, or the acting as an agent or broker for any person for any of these activities, of any goods or services.

T. If Applicant has any questions concerning the meaning, interpretation or answers to these interrogatories, or subparts thereof, direct such inquiries to the undersigned.

### **INTERROGATORIES**

1. Identify the nature of Applicant’s organization.
2. State when Applicant first adopted an intent to use Applicant’s Mark.
3. Identify each of Applicant’s members, managing members, principals or other managing agents.

4. Identify each person who participated in the determination to adopt an intent to use Applicant's Mark.

5. State whether Applicant has made use of Applicant's Mark, and if so when such use completed.

6. Identify all searches conducted by Applicant regarding Applicant's Mark.

7. State when and how Applicant first became aware of Opposer and identify all documents and electronic data evidencing or referring to such awareness.

8. Identify all persons who will be responsible for marketing or intended marketing of the goods and/or services provided under Applicant's Mark.

9. Identify all of Applicant's registration(s) or currently pending application(s) for Applicant's Mark, or a mark incorporating "MIA" or "LISIA" or both in the United States Patent and Trademark Office, in any of the States of the United States or in the Trademark Office of any foreign country.

10. Identify any expert witness and the substance of the expected testimony of such witness that Applicant intends to obtain testimony from in this proceeding.

11. Identify each fact witness and the substance of the testimony expected from each such witness that Applicant plans to call as a witness in this proceeding.

12. In relation to each person identified in response to Interrogatory No. 10 and Interrogatory No. 11, identify all communications with each such person, concerning Applicant or this proceeding.

13. Identify any communications with any person, other than employees of Applicant or attorneys for Applicant, concerning Opposer or this proceeding.

14. Identify each person or entity licensed to use Applicant's mark, in whole or in part, on goods, advertisements or on a website.

15. Identify all websites used by Applicant's licensees or any other person affiliated with Applicant, which use or feature Applicant's mark, or MIA or LISIA or both, in their content and/or domain name.

16. Identify by name, address, and title, each person who furnished information respecting the answers to the foregoing interrogatories.

Respectfully submitted,



Date: January 23, 2014  
New York, New York

By: \_\_\_\_\_  
SPRINGUT LAW PC  
75 Rockefeller Plaza, 19<sup>th</sup> Floor  
New York, New York 10019  
Tel: (212) 813-1600  
*Attorneys for Opposer*

### **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true copy of the above **OPPOSER'S SET OF INTERROGATORIES TO APPLICANT** was served upon Applicant's attorney of record, by first class mail, postage prepaid, and by email, addressed to Christopher J. Day, Esq., Law Office of Christopher Day, 9977 North 90<sup>th</sup> Street, Suite 155, Scottsdale, AZ 85258, *chris@daylawfirm.com* on this 23<sup>rd</sup> day of January 2014.

By: /s/ Tal S. Benschar  
Tal S. Benschar

**MOTION TO COMPEL**

**EXHIBIT B**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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ACT II JEWELRY, LLC d/b/a lia sophia,

*Opposer,*

Opposition No.

v.

Serial No.: 85/912651

ALISIA & COMPANY

Mark: MIALISIA & CO.

*Applicant.*

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**OPPOSER’S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS  
PURSUANT TO 37 C.F.R. §2.120 AND FED.R.CIV.P. 34**

Pursuant to 37 C.F.R. §2.120 and Rule 34 of the Federal Rules of Civil Procedure, Opposer Act II Jewelry, LLC d/b/a lia sophia (hereinafter referred to as “Opposer”), hereby requests that applicant, Alisia & Company, Inc. (hereinafter referred to as “Applicant”), produce copies of the documents identified below at the offices of Springut Law P.C. within (30) days from the date of service of this document and further, that such documents be organized and labeled to correspond with the categories in the request pursuant to F.R.C.P. Rule 34(b).

## **Instructions and Definitions**

The instructions and definitions set forth in Opposer's First Set of Interrogatories To Applicant are incorporated herein by reference as if set forth fully below.

## **REQUESTS FOR PRODUCTION**

1. All documents, electronic data and things identified or required to be identified in Applicant's Initial Disclosures.
2. All documents, electronic data and things that contain any information used to provide answers for or identified in any of Applicant's responses to Opposer's First Set of Interrogatories to Applicant.
3. All documents, electronic data and things evidencing or referring to any searches or investigations conducted by or for Applicant in connection with Applicant's Mark.
4. All documents, electronic data and things evidencing the intent to use by Applicant of Applicant's Mark in connection with any goods and/or services.
5. Documents, electronic data and things sufficient to identify all officers, directors, members, managing members or managing agents, of Applicant since date when Applicant first adopted Applicant's Mark.
6. All documents, electronic data and things evidencing any trademark or trade name applications filed by or for Applicant under any mark including "MIA" or "LISIA", or both.
7. All documents, electronic data and things evidencing or referring to any correspondence or communications between Applicant and Opposer.
8. All documents, electronic data and things evidencing or referring to market projections of Applicant's future sales of any products or services under Applicant's Mark.



9. All documents evidencing any search for any mark including the words “MIA” or “LISIA”, or both, conducted by or for Applicant, in relation to federal trademark registrations, state trademark registrations, online databases or other referenced works.

10. A copy of any agreement between Applicant and any other person concerning use of Applicant’s Mark.

11. To the extent not produced in response to any of the preceding document requests, all Documents, electronic data and things that Applicant relies upon in support of any allegations or defenses set forth in Applicant’s Answer to Notice of Opposition.


12. All documents, electronic data and things evidencing or referring to any application for registration of Applicant’s Mark in any trademark office outside of the United States.

13. All documents, electronic data and things evidencing or referring to any prosecution of any application for registration of Applicant’s Mark in any trademark office outside of the United States.

14. All licenses to use Applicant’s marks or any portion thereof.

15. Documents sufficient to identify all websites which use or feature Applicant’s mark, or MIA or LISIA or both, in their content and/or domain name.

Date: January 23, 2014  
New York, New York

By:   
\_\_\_\_\_  
SPRINGUT LAW PC  
75 Rockefeller Plaza, 19<sup>th</sup> Floor  
New York, New York 10019  
Tel: (212) 813-1600  
*Attorneys for Opposer*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true copy of the above **OPPOSER'S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS** was served upon Applicant's attorney of record, by first class mail, postage prepaid, and by email, addressed to Christopher J. Day, Esq., Law Office of Christopher Day, 9977 North 90<sup>th</sup> Street, Suite 155, Scottsdale, AZ 85258, *chris@daylawfirm.com* on this 23<sup>rd</sup> day of January 2014.

By:           /S/ Tal S. Benschar            
Tal S. Benschar

**MOTION TO COMPEL**

**EXHIBIT C**

**Tal S. Benschar**

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**From:** Tal S. Benschar  
**Sent:** Friday, March 07, 2014 1:15 PM  
**To:** 'chris@daylawfirm.com'  
**Cc:** Milton Springut  
**Subject:** Act II Jewelry v. Alisia & Co.

Chris:

We served you with discovery requests on January 23rd. Responses are now a week overdue. When can we expect to receive responses?

Tal Benschar